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THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Patent No. : 7,504,437

Issue Date : March 17, 2009

Serial No. : 10/629,108

Applicants : Kazuo KOYAMA et al.

Filed : July 28, 2003

For : BENZYLAMINE ANALOGUES

Art Unit : 1625

Examiner : Dr. Taofiq A. SOLOLA

Docket No. : 03338CIP/HG

Confirm. No. : 6344

Customer No. : 01933

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Commissioner for Patents,
P.O. Box 1450
Alexandria, VA 22313-1450

Dorothy DeFrancesco
Dorothy DeFrancesco

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connection with this Paper to
Account No. 06-1378.

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

1. This is a request for reconsideration of the patent term adjustment of 58 days indicated in the above-identified issued patent. It is respectfully requested that applicants be afforded a patent term adjustment of 146 days, i.e., an additional 88 days of patent term adjustment.

2. This application for patent term adjustment is being filed within two months of the issue date (37 CFR §1.705(d)).

3. Applicants submit herewith a "Statement of the Correct Patent Term Adjustment: Basis Under 37 CFR §1.702 For the Adjustment (37 CFR §1.705(b)(2)(i) and (ii))."

4. The above-identified patent is not subject to a terminal disclaimer (37 CFR §1.705(b)(2)(iii)).

5. As to any circumstances during the prosecution of this patent constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent as set forth in §1.704 (37 CFR §1.705(b)(2)(iv)): there was none (37 CFR §1.705(b)(2)(iv)(B)).

6. The fee set forth in §1.18(e) (\$200), required by 37 CFR §1.705(b)(1), is paid as follows:
Attached is a Form PTO-2038 in the amount of \$200.

To the extent not tendered by Form PTO-2038 attached hereto, authorization is given to charge any additional fees to Deposit Account No. 06-1378.

It is respectfully requested that this application for patent term adjustment be granted and that a Certificate of Correction be issued to indicate a patent term adjustment of 146 days.

Respectfully submitted,



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RSB/ddf

Encs.: (1) Statement of the Correct Patent Term Adjustment:
Basis Under 37 CFR §1.702 For the Adjustment (37 CFR
§1.705(b)(2)(i) and (ii))

(2) Form PTO-2038



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to charge the extension
fee, or any other fee required in
connection with this Paper to
Account No. 06-1378.

STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT:

BASIS UNDER 37 CFR §1.702 FOR THE ADJUSTMENT

(37 CFR §1.705(b)(2)(i) AND (ii))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

1. This statement is being submitted in support of the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))" to which this statement is attached.

37 CFR §1.705(b)(2)(i)

2. The patent term adjustment indicated in the above-identified patent is 58 days. It is respectfully submitted that such indication of patent term adjustment is in error, due to the improper inclusion of a 88 day applicant delay with respect to the following:

(a) applicants' submission of a LETTER RE: NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT, filed December 12, 2008 (which was erroneously assessed by the USPTO as an applicant delay of 23 days); and

(b) applicants' submission of a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008, filed January 12, 2009 (which was erroneously assessed by the USPTO as an applicant delay of 65 days).

It is respectfully submitted that the correct patent term adjustment under 37 CFR §1.702 is 146 days.

37 CFR §1.705(b)(2)(ii)

3. The basis on which applicants seek a redetermination of the patent term adjustment is as follows.

a. Applicants received from the USPTO a NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT dated December 9, 2009 ("December 9, 2009 NOTICE"), which stated that applicants' INFORMATION DISCLOSURE STATEMENT ("IDS") filed October 24, 2008 was not compliant with 37 CFR 1.97(d) because the IDS lacked a statement as specified in 37 CFR 1.97(e).

In reply to the December 9, 2009 NOTICE, on December 12, 2009, applicants filed a LETTER RE: NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT ("December 12, 2009 LETTER"). In applicants' December 12, 2009 LETTER, it was stated that applicants' IDS filed on October 24, 2008 was filed after the submission of a RCE on October 8, 2008 and before the mailing of a Notice of Allowance on November 18, 2008, and therefore it was timely filed under 37 CFR 1.97(a)(4), which is reproduced as follows:

"(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following periods:

* * *

(4) Before the mailing of a first Office Action after the filing of a request for continued examination under §1.114."

In a USPTO Communication mailed December 31, 2008, the following was stated:

"This is in response to your letter of 12/12/08 contending that the IDS filed 10/24/08 is timely filed, the papers filed on 10/24/08 are timely filed...."

Accordingly, the Examiner agreed with applicants that their October 24, 2008 IDS was timely filed and thus the December 9, 2009 NOTICE was erroneous.

Enclosed is a copy of the Patent Term Adjustment History that was obtained from the USPTO website for the above-identified patent. The Patent Term Adjustment History shows a 23 day applicant delay for the following entry:

<u>Date</u>	<u>Contents Description</u>
12-09-2008	Miscellaneous Incoming Letter

Initially it is noted that there was no incoming letter on December 9, 2008, but rather the mailing of the aforesaid USPTO NOTICE on December 9, 2009. It is considered that such 23 day applicant delay was attributed to applicants' December 12, 2009 LETTER.

As shown from the above, applicants' December 12, 2009 LETTER was in reply to the erroneous USPTO December 9, 2009 NOTICE. Accordingly, it is respectfully submitted that the 23 day applicant delay be rescinded.

b. As discussed hereinabove, applicants received a USPTO COMMUNICATION mailed December 31, 2008. In reply to said December 31, 2008 COMMUNICATION, applicants filed on January 12, 2009 a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 31, 2008 ("December 31, 2008 LETTER").

The following was stated in the USPTO COMMUNICATION dated December 31, 2008:

"The papers filed on 10/24/08 are timely filed but they are Office actions sent to an Examiner who issued the actions as well as IDSs previously considered and signed by the same Examiner. Informing the Examiner of his Office actions and/or previous IDSs does not constitute a proper IDS as there is nothing to inform or disclose to the Examiner which he/she didn't know. This has the potential to cause serious confusion with the Office Legal Instrument Examiners and returning an Examiner's action to him/her has the potential of wasting time and delaying prosecution."

The purpose of applicants' December 31, 2008 LETTER was to correct misstatements of the Examiner in the above quoted paragraph, so that the record could be clarified.

The above quoted paragraph refers to copies of Office Actions in copending family member applications that were submitted in applicants' IDS filed on October 24, 2008. In the December 31, 2008 LETTER, it was asserted that the October 24, 2008 IDS was a proper Information Disclosure Statement in that it presented material information, i.e., copies of Office Actions in copending related applications, with respect to patentability. The submission of copies of Office Actions in copending related applications was held to be an appropriate procedure in McKesson Information Solutions, Inc. v. Bridge Medical, Inc., 82 USPQ 2d 1865, 1885 (Fed. Cir. 2007). The following is stated in 82 USPQ 2d 1885:

"Moreover, the MPEP at the time explained that a prosecuting attorney should not assume that [a PTO examiner] retains details of every pending file in his mind when he is reviewing a particular application. MPEP §2001.06(b) (5th ed. rev. 3, 1986) (quoting *Armour & Co. v. Swift & Co.*, 466, F.2d 767, 779 [175 USPQ 70] (7th Cir. 1972)), and PTO regulations required all disclosures to be in writing, 37 C.F.R. §1.2; see also MPEP §2002.02 (5th ed. rev. 3, 1986)."

The enclosed copy of the Patent Term Adjustment History for the above-identified patent shows a 65 day applicant delay for the following entry:

<u>Date</u>	<u>Contents Description</u>
1-12-2009	Miscellaneous Incoming Letter

The aforesaid 65 day applicant delay was thus assessed for applicants' January 12, 2009 LETTER, which was submitted to the USPTO to correct misstatements in the USPTO COMMUNICATION dated December 31, 2008 and to clarify the record.

It is therefore respectfully submitted that the 65 day applicant delay be rescinded.

Respectfully submitted,



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RSB/ddf

Enclosure: copy of Patent Term Adjustment History
for Appln. No. 10/629,108 (4 sheets)

10/629,108	BENZYLAMINE ANALOGUES	05-08-
		2009:09:53:18

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/629,108

Filing or 371(c) Date:	07-28-2003	USPTO Delay (PTO) Delay (days):	289
Issue Date of Patent:	03-17-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	118
Post-Issue Petitions (days):	+0	Total PTA (days):	58
USPTO Adjustment(days):	-113	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
03-17-2009	Patent Issue Date Used in PTA Calculation		
02-13-2009	Dispatch to FDC		
02-04-2009	Issue Fee Payment Verified		
02-04-2009	Issue Fee Payment Received		
02-03-2009	Mail-Record a Petition Decision of Granted for Patent Term Adjustment after Allowance		
02-03-2009	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance		
02-03-2009	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance		
02-02-2009	Adjustment of PTA Calculation by PTO		
02-02-2009	Adjustment of PTA Calculation by PTO	30	
02-02-2009	Adjustment of PTA Calculation by PTO		↑
02-02-2009	Adjustment of PTA Calculation by PTO	42	
02-02-2009	Adjustment of PTA Calculation by PTO		↑
02-02-2009	Adjustment of PTA Calculation by PTO	41	
01-12-2009	Miscellaneous Incoming Letter		65
12-31-2008	Mail Miscellaneous Communication to Applicant		↑
12-24-2008	Miscellaneous Communication to Applicant - No Action Count		
12-18-2008	Pubs Case Remand to TC		
12-09-2008	Pubs Case Remand to TC		
12-09-2008	Miscellaneous Incoming Letter		23
12-09-2008	Mail PUB Notice of non-compliant IDS		
12-09-2008	PUB Notice of non-compliant IDS		
11-25-2008	Petition Entered		
11-18-2008	Mail Notice of Allowance		
11-18-2008	Document Verification		
11-18-2008	Notice of Allowance Data Verification Completed		
11-14-2008	Mail-Petition Decision - Dismissed		
11-14-2008	Petition Decision - Dismissed		
10-08-2008	Reference capture on IDS		

10-08-2008	Information Disclosure Statement (IDS) Filed	
10-08-2008	Date Forwarded to Examiner	
10-08-2008	Request for Continued Examination (RCE)	
11-13-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
10-08-2008	Information Disclosure Statement considered	
10-08-2008	Information Disclosure Statement (IDS) Filed	
10-14-2008	Mail-Record Petition Decision of Granted to Withdraw from Issue	
10-14-2008	Record Petition Decision of Granted to Withdraw from Issue	
10-08-2008	Workflow - Request for RCE - Begin	
10-08-2008	Petition Entered	
05-08-2008	Petition Entered	
06-23-2008	Mail Response to 312 Amendment (PTO-271)	
06-19-2008	Response to Amendment under Rule 312	
05-14-2008	Amendment after Notice of Allowance (Rule 312)	
05-20-2008	Application Is Considered Ready for Issue	
05-15-2008	Issue Fee Payment Verified	
05-15-2008	Issue Fee Payment Received	
01-24-2008	Miscellaneous Incoming Letter	
02-20-2008	Mail Notice of Allowance	155
06-26-2007	Document Verification	↑
06-26-2007	Notice of Allowance Data Verification Completed	↑
06-13-2007	Miscellaneous Incoming Letter	↑
06-01-2007	Date Forwarded to Examiner	↑
05-18-2007	Response after Non-Final Action	↑
09-21-2006	Information Disclosure Statement considered	
09-21-2006	Information Disclosure Statement (IDS) Filed	
06-05-2006	Information Disclosure Statement considered	
06-05-2006	Information Disclosure Statement (IDS) Filed	
05-03-2006	Information Disclosure Statement considered	
05-03-2006	Information Disclosure Statement (IDS) Filed	
03-21-2007	Mail Non-Final Rejection	82
03-19-2007	Non-Final Rejection	↑
09-28-2006	Information Disclosure Statement considered	↑
08-29-2006	Information Disclosure Statement considered	↑
09-28-2006	Information Disclosure Statement (IDS) Filed	↑
09-28-2006	Information Disclosure Statement (IDS) Filed	↑
08-29-2006	Information Disclosure Statement (IDS) Filed	↑
08-29-2006	Information Disclosure Statement (IDS) Filed	↑
02-26-2007	Date Forwarded to Examiner	↑

08-29-2006	Request for Continued Examination (RCE)	
02-26-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	↑
02-26-2007	Case Docketed to Examiner in GAU	
08-29-2006	Workflow - Request for RCE - Begin	
06-22-2006	Mail Miscellaneous Communication to Applicant	
06-19-2006	Miscellaneous Communication to Applicant - No Action Count	
05-30-2006	Mail Notice of Allowance	
05-25-2006	Notice of Allowance Data Verification Completed	
05-25-2006	Case Docketed to Examiner in GAU	
05-11-2006	Date Forwarded to Examiner	
05-03-2006	Response after Non-Final Action	30
05-03-2006	Request for Extension of Time - Granted	↑
01-03-2006	Mail Non-Final Rejection	↑
11-16-2005	Non-Final Rejection	
09-16-2005	Information Disclosure Statement considered	
09-16-2005	Reference capture on IDS	
09-16-2005	Information Disclosure Statement (IDS) Filed	
09-16-2005	Information Disclosure Statement (IDS) Filed	
09-26-2005	Date Forwarded to Examiner	
09-26-2005	Date Forwarded to Examiner	
09-16-2005	Request for Continued Examination (RCE)	
09-26-2005	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
09-16-2005	Workflow - Request for RCE - Begin	
06-17-2005	Mail Final Rejection (PTOL - 326)	
06-16-2005	Final Rejection	
05-26-2005	Date Forwarded to Examiner	
05-17-2005	Response after Non-Final Action	
04-25-2005	Correspondence Address Change	
02-22-2005	Mail Non-Final Rejection	
02-18-2005	Non-Final Rejection	
12-20-2004	Reference capture on IDS	
12-20-2004	Information Disclosure Statement (IDS) Filed	
12-20-2004	Information Disclosure Statement (IDS) Filed	
01-15-2005	Date Forwarded to Examiner	
12-20-2004	Response to Election / Restriction Filed	
12-20-2004	Workflow incoming amendment IFW	
11-19-2004	Mail Restriction Requirement	52
11-18-2004	Requirement for Restriction / Election	↑
04-29-2004	IFW TSS Processing by Tech Center Complete	↑

04-29-2004	Case Docketed to Examiner in GAU	↑
10-23-2003	Preliminary Amendment	↑
04-25-2004	Case Docketed to Examiner in GAU	↑
03-02-2004	IFW TSS Processing by Tech Center Complete	↑
10-23-2003	Preliminary Amendment	↑
10-22-2003	Information Disclosure Statement (IDS) Filed	↑
10-22-2003	Information Disclosure Statement (IDS) Filed	↑
12-12-2003	Application Return from OIPE	↑
12-12-2003	Application Return TO OIPE	↑
12-12-2003	Application Dispatched from OIPE	↑
12-12-2003	Application Is Now Complete	↑
10-22-2003	Additional Application Filing Fees	↑
07-28-2003	Claim Preliminary Amendment	↑
10-22-2003	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑
10-20-2003	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
10-11-2003	Cleared by OIPE CSR	↑
09-19-2003	IFW Scan & PACR Auto Security Review	↑
07-28-2003	Initial Exam Team nn	↑

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